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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,092	12/21/2001	Jerome Branter	Roof	8292

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EXAMINER

YIP, WINNIE S

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,092

Applicant(s)

BRANTER, JEROME

Examiner

Winnie Yip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Part II DETAILED ACTION

This office action is in response to applicant's amendment filed on October 20, 2003 .

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

1. Claim 1 is objected to because of the following informalities: the term "tow" (line 2) appears should read "two". And, the terms "upright" (line 2) and "scaffolding" (line 4) lack a proper antecedent basis. It appears should read "an upright". Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. Claims 1 and 5-10 stand rejected under 35 U.S.C. 102(b) as being anticipated by UK Patent No. 2,157,755.

UK reference shows and discloses a roof retaining apparatus comprising a framework including at least two angulated arms (no numbered), an upright (5, 6) engaged to each arm, each upright having a top lateral sleeve (11), an upper cross member (4) and a lower cross member (16) engaged to and between uprights, said upper cross member having ends being slideable received by the sleeves (11) on the uprights, the arm having a flat portion being secured to a roof, the arm having a structure such as a brace (17) for mounting scaffolding thereover, and at least one net (18) stretched between and fixed to the uprights and cross members, wherein the net is removably secured to the upright and cross members by cooperating

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securement devices such as hooks which inherently via eyes (see lines 87-88) for providing a safety feature to prevent an operative from falling from the roof of a building.

1. Claims 1, 5-8, and 11 stand rejected under 35 U.S.C. 102(b) as being anticipated by Elkins et al. (US Patent No. 5,779,227).

Elkins et al. shows and discloses a roof retaining apparatus comprising a framework including at least two angulated arms (16) each having a flat portion (38) being mounted to a roof, an upright (40) engaged to the flat portion of each arm, each upright having a top and bottom lateral sleeve (48, 49), an upper cross member (20) and a lower cross member (22 or 24) engaged to and between uprights, said cross members each having ends being secured to the sleeves of the uprights by pins (44, 50), the arm having a structure such as a brace (41) for mounting scaffolding thereover, and at least one net (28) stretched between and fixed to the uprights and cross members by suitable securement device.

Claim Rejections - 35 USC § 103

2. Claims 1-7, 9, 11, 14-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Probst (US Patent No. 3,901, 481) in view of UK Patent No. 2,157,755.

Probst shows and discloses a roof retaining apparatus comprising a framework including at least two angulated arms, each arm having a flat portion (6) having a plurality of angular slots (10) at a free end of the flat portion to engage with fasteners such as nails (9) for securing the arm to a roof (8), each arm having vertical sleeve (15) and an upstanding flange (21), the upstanding flange (21) forming a channel-shaped bracket that provides a structure for mounting

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scaffolding (22) thereon, an upright (24) having a lower end being received and engaged by the vertical sleeve (15) to each of the arms, each upright (24) having at least a top and bottom lateral sleeves (26, 28), an upper cross member (27) and a lower cross member (29) each having ends being slideable received by the sleeves (26 or 28) on two uprights respectively, said each sleeve having bores receiving with a pin (30) therein to engage and secure the ends of cross members to the uprights. Probst fails to define the roof retaining apparatus including a net stretched between and fixed to the uprights and the cross members as claimed. UK reference teaches a roof retaining apparatus comprising a framework including uprights and cross members, and a net having securement device such as hooks (19, 20) along the edges of the net to hang the net pivoting from an upper cross member and rest against a lower cross member. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the roof retaining apparatus of Probst having a net hooked and stretched between the cross members and fixed to the framework as taught by UK reference for providing a safety device with additional safety features for preventing an operative falling from the roof of the building.

3. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Probst '481 in view of UK Patent '755 as applied to claim 1 above, and further in view of Pedley (US Patent No.3,527,319).

Claims are considered to be met by Probst combined with UK reference as explained and applied above rejections except that either Probst or UK reference does not define the roof retaining device including the upright and cross members having cooperating securement devices comprise eyes for cooperatively receiving the securement devices along the edges of a net for

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detachably securing the net between the cross members. Pedley teaches a roof safety device comprising a framework including uprights (15) and cross members (14), and a net (1) detachably mounted to the framework, wherein the net (1) includes hooks (24) providing securement devices mounted along the edges of the net, the framework including eyes (25) mounted on the uprights each having a plurality of eyes providing cooperative securement device for cooperatively receiving the hooks of the net for detachably mounted the net to the framework. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the roof retaining apparatus of Probst combined with UK reference having the framework providing with cooperating securement devices such eyes to cooperatively receive the securement device such as hooks formed along the edges of the net as taught by Pedley, as a well know removable cooperative mounting mechanism, for detachably securing the net to the framework to provide a safety device to the roof retaining apparatus.

4. Claims 12-13 and 16-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Probst '481 in view of UK Patent '755 as applied to claims 1 and 11 above, and further in view of Murray (US Patent No. 6,053,281).

Claims are considered to be met by Probst combined with UK reference as explained and applied above rejections except that either Probst or UK reference does not define the sleeve, the upright, and the cross member end flanges of the apparatus having bores being aligned together and a pin being engaged through the aligned bores for securing the upright and the cross member together. Murray teaches a safety device comprising an arm being secured to a building roof, a vertical sleeve (32) latterly mounted on the arm, and an upright post (12) having lower end being

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received into the vertical sleeve (32) , wherein the vertical sleeve (32) and the lower end of the upright post (12) having bores being aligned each other and a pin (34) being engaged through the aligned bores for securing the upright post to the vertical sleeve. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the roof retaining apparatus of Probst combined with UK reference having the upright, the cross member, and the sleeves respectively having bores aligned each other to receive a pin passed therethrough as taught by Murray, as an old and well know connecting mechanism, instead of having a pin to engage an inside member of Probst for removably and adjustably mounting two structural elements together.

Response to Argument

5. Applicant's arguments filed October 20, 2003 have been fully considered but they are not deemed to be persuasive.

a. In response to Applicant's argument that UK reference '755 request two frameworks one to each side of the ridge of the roof which is not required by Applicant's invention, it must be noted that UK reference discloses the invention as claimed. Anticipation is established when a single prior art reference discloses, expressly or under principles of inherence, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 772, 218 USPQ

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781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). In this case, the UK reference discloses a frame secured on one side of the ridge of the roof including all structural limitation as claimed. UK reference discloses that frame including at least two angulated arms each mounted to a side of the roof by an elongated member (1, 2) and a feet member (12). Wherein the elongated member (1 or 2) and the feet member (12) are considered to be the structure for mounting the angulated arms to the roof as claimed since applicant does not specifically define how the angulated arms being mounted to the roof into the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the rejected claims. In fact that it discloses additional structure not claimed is irrelevant.

b. In response to applicant's argument that Elkins et al. '227 does not disclose a roof retaining apparatus, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, Elkins et al. disclose an apparatus comprising a framework including elements for mounting a net and scaffolding on a structural surface as recited in the rejected claimed. Elkins et al. discloses the framework including angulated arms (38) that is used to mount on a surface which is capable to be a roof surface as claimed since applicant does not specifically claim the scaffolding and how the scaffolding being mounted to the apparatus, and how the apparatus

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being mounted to the roof. Therefore, the apparatus of Elkins et al. is considered in the same field of applicant's endeavor.

c. In response to applicant's argument that there is no suggestion to combine the references of Probst and UK references '755, and further Murray, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Probst and UK reference '755 and Murray teach various roof retaining apparatus for providing a safety device over a pitched roof for preventing the workmen or equipment falling from the roof as the same field of applicant's endeavor. UK reference is used as a reference only to teach mounting a net between the rails to fill the spaced between the rails for providing additional safety features. Murray is used as a reference only to teach two structural members having aligned bores to receive a pin for more securing and detachably mounting the two members together. All of the foregoing is within the skills, competence and knowledge of the person with ordinary skills in the constructional arts. Therefore, it would have been obvious to one ordinary skill in the art, at the time the invention was made to modify the safety device of Probst having a net mounted to the rails to fill the space between the rails as taught by UK references to provide additional safety means and having the upright and cross member having aligned bore to receive a pin therethrough as taught by Murray to more securely connecting two members together.

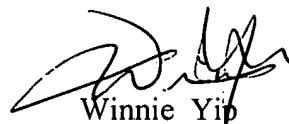
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d. In response to applicant's argument that there is no suggestion and motivation to combine the references of Probst with UK references '755, and further Brueske, it is deemed persuasive. Therefore, the rejection in view of Brueske has been withdrawn. However, a new ground of rejection is give as set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 703-308-2491. The examiner can normally be reached on M-F (9:30-6:30), Second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Winnie Yip
Primary Examiner
Art Unit 3637

wsy
January 9, 2004